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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,216	03/31/2004	Leon Edward Gregg	ROC920040029US1	7113
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IBM CORPORATION ROCHESTER IP LAW DEPT. 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			EXAMINER WALTER, CRAIG E	
			ART UNIT	PAPER NUMBER
			2188	
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			05/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,216

Applicant(s)

GREGG ET AL.

Examiner

CRAIG E. WALTER

Art Unit

2188

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-10,12-15,19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-10,12-15,19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 March 2008 has been entered.

Status of Claims

2. Claims 1, 2, 7-10, 12-15, 19 and 21 are pending in the Application.
Claims 3-6, 11, 16-18, 20 and 22 are cancelled.
Claims 1, 13 and 19 are amended.
Claims 1, 2, 7-10, 12-15, 19 and 21 are rejected.

Response to Amendment

3. Applicant's amendments and arguments filed on 24 March 2008 in response to the office action mailed on 28 December 2007 have been fully considered, but they are not persuasive. Therefore, the rejections made in the previous office action are maintained, and restated below, with changes as needed to address the amendments.

Claim Objections

4. Claim 12 is objected to because of the following informalities:

As for claim 12, the phrase "recited in claim 11" should be changed to "recited in claim 1".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 13-15, 19 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As for claim 13, the "computer-readable medium" as recited in this claim is directed to both statutory (e.g. floppy disks) and non-statutory (e.g. transmission media) subject matter as per paragraph 0028, all lines of Applicant's original specification. As such, the claim is held to be non-statutory.

A similar rejection applies to claim 19, since the apparatus in the computer system is exclusively defined by code and a computer-readable medium (which includes non-statutory subject matter as discussed above). As such, the claim is held to be non-statutory.

Claims 14, 15 and 21 are rejected for inheriting the deficiencies of each of their respective base claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 7-10, 12-15, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonhardt et al. (US Patent 5,164,909), hereinafter Leonhardt, in view of Hwang (US Patent 6,058,082).

As for claim 1, Leonhardt discloses a method for implementing device selection in a robotic media library with multiple media types and multiple device types (Col. 1 Lines 40-52) comprising the steps of:

storing a first media technology indicator with predefined media information to identify a required technology for each media (Fig. 14 Volume Attributes 1401; data storage image includes definition of the type of media Col. 13 Lines 13-15);

storing a second device technology indicator to describe each said device in the robotic media library (Fig 14 Drive Attributes 1402; data storage image includes definition of the type of media Col. 12 Lines 65-68).

identifying an operation request to the robotic media library (Fig. 11 user requests access 1101);

responsive to said operation request, checking for multiple device types in the robotic media library (Fig. 11 generate prioritized list of available media drives 1107);

responsive to identifying the multiple device types in the robotic media library and a default value for said first indicator, selecting a first device type (Fig. 11 select media type 1106) and placing media in said selected device (Fig. 11 mount media element on selected drive 1111); and

selecting a device of said selected first device type (Fig. 11 select specific media drive 1110).

Though Leonhardt further discloses the steps of checking for a successful operation (the retrieved media is loaded onto the drive element where it is read in the usual fashion Col. 4 Lines 54-56 a drive inherently checks for successful operation), he does not expressly disclose responsive to an unsuccessful operation, selecting a next device type.

Hwang however teaches detecting an error and determining the type of media based on comparison (Col. 1 Lines 49-62; specifically responsive to detecting an error begins trying the next type of media as in Fig. 5 i.e. item 501 is test that results in determining either no disc as in 502 or try next media as in item 503 which is a test for determining if media is a multi-layered DVD as in item 304).

Leonhardt and Hwang are from the same field of endeavor that is the art of handling multimedia devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include a method of discriminating media as in

Hwang in the system of Leonhardt in order to quickly discriminate the type of storage being used (Hwang Col. 1 Lines 32-39).

Additionally note, though Leonhardt does not expressly disclose selecting the newest device type in the robotic media library for said first device type, Examiner took official notice in the previous Office action (mailed 7 June 2007) that selecting the newest type of media as the first type is an obvious design choice in view of the need to write data on newly implemented media in order to phase out older media.

Applicant is entitled to traverse any/all official notice taken in the previous Non-final action. MPEP § 2144.03 (section C.) states, "[in order to] adequately traverse such a finding [of Office Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.... [i]f applicant does not traverse the examiner's assertion of official notice ... the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant ... failed to traverse the examiner's assertion of official notice...".

Since Applicant failed to traverse Examiner's assertion of Office notice in response to the previous Non-final Office action (7 June 2007), Examiner construes this limitation of selecting the newest device type as being commonly known in the art as admitted prior art, and the rejection is hereby made FINAL.

As for claim 2, Leonhardt discloses the steps responsive to said operation request, of setting a device type from said predefined media information (Fig. 11 review data file for attributes and constraints 1104 results in select media type 1106).

As for claim 12, Leonhardt discloses the steps of storing said second indicator with predefined information for each said device in said robotic media library (Fig 14 Drive Attributes 1402; data storage image includes definition of the type of media Col. 12 Lines 65-68).

As for claims 13-15, Leonhardt discloses a computer-readable medium encoded with a computer program product (automated cartridge library software Fig. 1 Item 110, Col. 3 Line 30) for implementing device selection in a robotic media library in a computer system, said computer program product including instructions executed by the computer system to cause the computer system to perform the steps recited in claims 1-3. As such these claims are rejected based on the same rationale as claims 1-2, *supra*. Additionally note, Leonhardt discloses the step of selecting said first device type as including the steps of storing a value representing said first device type for said first indicator (Fig 14 Drive Attributes 1402; data storage image includes definition of the type of media Col. 12 Lines 65-68).

As for claim 19, Leonhardt discloses an apparatus in a computer system for implementing device selection in a robotic media library comprising:

a computer-readable medium encoded with a stored media information (Fig. 14 Volume Attributes 1401);

said computer-readable medium encoded with a first indicator stored with predefined media information to identify a required technology for each media (Fig. 14 Volume Attributes 1401; data storage image includes definition of the type of media Col. 13 Lines 13-15);

said computer-readable medium encoded with a device selection control program, said device selection control program stores a second indicator to describe each said device in the robotic media library (Fig 14 Drive Attributes 1402; data storage image includes definition of the type of media Col. 12 Lines 65-68);

said device selection control program including instructions executed by the computer system to cause the computer system to perform the steps (automated cartridge library software Fig. 1 Item 110, Col. 3 Line 30) of identifying an operation request to the robotic media library; responsive to said operation request, for checking for multiple device types in the robotic media library (Fig. 11 generate prioritized list of available media drives 1107); responsive to identifying the multiple device types in the robotic media library and a default value for said first indicator, for selecting a first device type (Fig. 11 select media type 1106);

selecting a device of said selected first device type and placing media in said selected device (Fig. 11 select specific media drive 1110 and mount the media on the selected drive, element 1111).

Though Leonhardt further discloses the steps of checking for a successful operation (the retrieved media is loaded onto the drive element where it is read in the usual fashion Col. 4 Lines 54-56 a drive inherently checks for successful operation), he

does not expressly disclose responsive to an unsuccessful operation, selecting a next device type.

Hwang however teaches detecting an error and determining the type of media based on comparison (Col. 1 Lines 49-62; specifically responsive to detecting an error begins trying the next type of media as in Fig. 5 i.e. item 501 is test that results in determining either no disc as in 502 or try next media as in item 503 which is a test for determining if media is a multi-layered DVD as in item 304).

Leonhardt and Hwang are from the same field of endeavor that is the art of handling multimedia devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include a method of discriminating media as in Hwang in the system of Leonhardt in order to quickly discriminate the type of storage being used (Hwang Col. 1 Lines 32-39).

Additionally note, though Leonhardt does not expressly disclose selecting the newest device type in the robotic media library for said first device type, Examiner took official notice in the previous Office action (mailed 7 June 2007) that selecting the newest type of media as the first type is an obvious design choice in view of the need to write data on newly implemented media in order to phase out older media.

Applicant is entitled to traverse any/all official notice taken in the previous Non-final action. MPEP § 2144.03 (section C.) states, "[in order to] adequately traverse such a finding [of Office Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.... [i]f applicant does not traverse the examiner's assertion of official notice ... the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant ... failed to traverse the examiner's assertion of official notice...".

Since Applicant failed to traverse Examiner's assertion of Office notice in response to the previous Non-final Office action (7 June 2007), Examiner construes this limitation of selecting the newest device type as being commonly known in the art as admitted prior art, and the rejection is hereby made FINAL.

As for claim 21, Leonhardt discloses wherein said device selection control program responsive to media being placed in said selected device, performs checking for successful operation, and responsive to said successful operation, continues with a requested operation (the retrieved media is loaded onto the drive element where it is read in the usual fashion Col. 4 Lines 54-56 a drive inherently checks for successful operation and concluding the requested operation is a natural result).

As for claim 7, though Leonhardt does not expressly disclose selecting the oldest device type in the robotic media library for said first device type, Examiner took Official notice in the previous Office action (mailed 7 June 2007) that selecting the oldest type of media as the first type is an obvious design choice in view of Leonhardt. As stated previously, a skilled artisan would recognize the need to select the next older medium in order to quickly locate data, which has a higher likelihood of being stored in older media.

Applicant is entitled to traverse any/all official notice taken in the previous Non-final action. MPEP § 2144.03 (section C.) states, "[in order to] adequately traverse such a finding [of Office Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.... [i]f applicant does not traverse the examiner's assertion of official notice ... the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant ... failed to traverse the examiner's assertion of official notice...".

Since Applicant failed to traverse Examiner's assertion of Office notice in response to the previous Non-final Office action (7 June 2007), Examiner construes this limitation of selecting the newest device type as being commonly known in the art as admitted prior art, and the rejection is hereby made FINAL.

As for claim 8, Leonhardt discloses the steps of selecting a second device of said selected next device type, placing media in said selected second device (Leonhardt Fig. 11 mount media element on selected drive 1111 will still naturally result in the event a second drive is chosen).

As for claim 9, the rejection of claim 1 above addressing the limitations presented here (with regards checking for successful operation, and selecting a next device type responsive to an unsuccessful operation, therefore this claim is rejected based on the same rationale as discussed in claim 1.

As for claim 10, Leonhardt discloses the steps of checking for successful operation, and responsive to said successful operation, continuing with a requested operation (the retrieved media is loaded onto the drive element where it is read in the usual fashion Col. 4 Lines 54-56 a drive inherently checks for successful operation and concluding the requested operation is a natural result).

Response to Arguments

7. Applicant's arguments with respect to claims 1, 2, 7-10, 12-15, 19 and 21 have been fully considered, but they are not persuasive.
8. With respect to the previously asserted § 101 rejections, though Examiner acknowledges Applicant's removal of non-statutory subject matter in specification, the § 101 rejections cannot be obviated without an explicit statement indicating the surrender of the subject matter, hence disavowing all claim to those non-statutory embodiments. As such, the § 101 rejections are maintained, and restated above.
9. With respect to the previously asserted § 103(a) rejections, (beginning on page 13 of the remark), Applicant contends (p. 13, ll. 3-8) that "Leonhardt fails to disclose or suggest any equivalent indicators as taught and claimed by applicant, as now expressly recited storing a first indicator with predefined media information to identify a required technology for each media; storing a second device technology indicator to describe each device in the robotic media library."

This argument however is not persuasive. More specifically, Examiner notes the recitation of a second indicator was presented in previously recited claim 11. Examiner maintains that Leonhardt teaches both first and second technology indicators with via the disclosed volume and drive attributes (Fig. 14, elements 1401 and 1402, respectively – see rejection above).

Applicant continues (p. 13, ll. 9-13) contending, "each of the independent claims 1, 13, and 19 require 'identifying a default value for said first indicator and then a first device type selected, and selecting a first device type including selecting a newest device type in the robotic media library for said first device type. Neither Leonhardt, nor Hwang teach or suggest these steps for implementing device selection in a robotic media library.'"

This argument however is not persuasive as it is substantially similar to the one set forth by Applicant in the remarks filed 4 September 2007 (p. 11, ll. 5-17). As such the rejection is maintained as per the rejection *supra*, and Examiner's retort in the action mailed 28 December 2007.

Lastly, Applicant asserts (p. 13, l. 14 through p. 14, l. 3), "as amended, [the claims] further recite the steps storing a second device technology indicator to describe each device in the robotic media library; selecting a device of said selected first device type and placing media in said selected device; and responsive to media being placed in said selected device, checking for successful operation, and responsive to an unsuccessful operation, selecting a next device type." Continuing, "[t]he step of storing

a second device technology indicator to describe each device in the robotic media library; is not suggested in the prior art references of record including Leonhardt and Hwang. As set forth above, Hwang teaches steps for identifying error operation; however, neither Leonhardt, nor Hwang teach or suggest these steps for selecting a next device type to implement device selection in a robotic media library, as taught and claimed in each of the independent claims 1, 13, and 19, as amended."

This argument however is not persuasive as it is substantially similar to the first argument set forth above (alleging that a second indicator is not present in the prior art), and the one set forth by Applicant in the remarks filed 4 September 2007 (p. 11, final paragraph). As such the rejection is maintained as per the rejection supra, and Examiner's retort in the action mailed 28 December 2007.

Applicant's argument that all dependant claims are allowable for further limiting at least on base claim is rendered moot, as Examiner maintains that all claims are rendered obvious as per the arguments and rejections set forth supra.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRAIG E. WALTER whose telephone number is (571)272-8154. The examiner can normally be reached on 8:30a - 5:00p M-F.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Souh can be reached on (571) 272-6799. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Craig E Walter/
Patent Examiner, Art Unit 2188

CEW

Application Number**Application/Control No.**

10/815,216

Examiner

CRAIG E. WALTER

**Applicant(s)/Patent under
Reexamination**

GREGG ET AL.

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